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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,995	01/18/2002	Norbert Becker	3286-0168P	7874
30596 7590 07/09/2007 HARNESSE, DICKEY & PIERCE, P.L.C. P.O.BOX 8910 RESTON, VA 20195			EXAMINER LY, ANH	
			ART UNIT 2162	PAPER NUMBER
			MAIL DATE 07/09/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/914,995

Applicant(s)

BECKER ET AL.

Examiner

Anh Ly

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is response to Applicants' AMENDMENT filed on 05/08/2007.
2. The Final Office Action mailed on 02/08/2007 was vacated.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 8-25 are rejected under 35 U.S.C. 101.
5. The "system" in claim 8 is not explicitly defined in the application specification, so it is as software per se.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 8, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: "automatic retrieval, in an automation system, of engineering data from a runtime system for an engineering system ... a multiplicity of individual runtime automation object" as set forth in the preamble of the claim, however, the body of claims do not appear to actually support the preamble by including a step or steps which accomplish that act.

### ***Drawings***

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the automation objects, type of respective representative to the engineering system, a reference to the corresponding automation" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. (also, all the feature or component must be labeled clearly)

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 4, 6, 7, 8, 11, 13, 14, 17 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub. No.: US 2001/0037161 A1 of Hess et al. (hereinafter Hess) (Continuation of application No.: PCT/DE99/03550).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claim 1, Hess teaches a method for automatic retrieval, in an automation system, of engineering data from a runtime system for an engineering system, and restoring representatives of the automation objects in the engineering

Art Unit: 2162

system, the automation system including a multiplicity of individual runtime automation objects in the runtime system, the runtime automation objects have no direct reference to any associated engineering objects in the engineering system, for the restoration of representatives in an engineering system of objects of the automation system (figs. 1 and 3, Movement Control (MC) application on an engineering system and for running of the MC application on a runtime system: section 0022 and 0028 and accessing or retrieving object on the runtime system: 0045 and fig. 4), the method comprising:

supplying, by each of the automation objects, an identifying designation of a type of respective representative to the engineering system (providing basic object to the system: 0009);

creating, via the engineering system, said representatives for the designated types and, for each of the representatives, entering a reference to the corresponding automation object (creating base object by entering the addressing or representation of objects: sections 0043-0045);

reading out, each representative read out engineering information from the object into the representative using the reference (accessing or reading the object on the system: sections 0041-0045); and

restoring each of the representatives by entering said information into itself (restoring the movement of application: section 0090).

With respect to claim 4, Hess teaches wherein both the objects of the engineering system and the objects of the automation system are described by a uniform, executable object model and a direct communication at model level is possible

between the objects of the engineering system and the objects of the automation system (engineering and automation objects and execution of objects: sections 0043 0053, 0068 and 0072; also see fig. 4 and section 0044-0045).

With respect to claim 6, Hess teaches wherein the objects of the automation system have no direct reference to the associated objects of the engineering system, to make it possible for the engineering system and automation system to be separated (sections 0072).

With respect to claim 7, Hess teaches wherein, the method is used for the updating of already existing engineering information as a delta method (updating or modification engineering information: sections 0054 and 0115).

Claim 8 is essentially the same as claim 1 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 11 is essentially the same as claim 4 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 13 is essentially the same as claim 6 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 6 hereinabove.

Claim 14 is essentially the same as claim 7 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 7 hereinabove.

With respect to claim 17, Hess teaches wherein entries in the lists with communication relationships contain sources and drains of the communication relationships, the sources and drains in each case being described by a triple from an identifier of the device, an identifier of the automation object and an identifier of the input or output (sections 0003, 0045 and 0055).

Claims 22 is essentially the same as claim 17 except that they are directed to a system rather than a method, and are rejected for the same reason as applied to the claim 17 hereinabove.

***Allowable Subject Matter***


11. Claims 2,3, 5, 15, 18, 16, 19, 25, 9, 10, 12, 20, 23, 21 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (by incorporating all the limitations of claim 2 into claim 1 and all the limitations of claim 9 into claim 8). **If overcoming the 101 rejections and objections above.**




**Contact Information**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV (**Written Authorization being given by Applicant (MPEP 502.03 [R-2])) or fax to (571) 273-4039 (Examiner's personal Fax No.)**). The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Breene**, can be reached on (571) 272-4107.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: **Central Fax Center: (571) 273-8300**

ANH LY   
JUN. 8<sup>th</sup>, 2007

  
JOHN BREENE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100  
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